Remarks/Arguments

Claims 1-21 are pending in this application. Claims 1, 8, and 15 have been amended to more clearly and distinctly claim the subject matter that applicants regard as their invention. No new matter is believed to be added by the present amendment.

Re: Rejection of Claims 1, 6, 8, 9, 14, 15 and 21 under 35 U.S.C. §103(a)

Claims 1, 6, 8, 9, 14, 15, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,987,221 issued to Platt (hereinafter, "Platt") in view of U.S. PGPub 2005/0076008 issued to Kudou (hereinafter, "Kudou"), and further in view of U.S. PGPub 2003/0144918 issued to Novelli (hereinafter, "Novelli"). Applicants respectfully traverse this rejection for at least the following reasons.

First, Applicants submit that the proposed combination of references fail to produce the claimed invention.

Kudou pertains to searching for a program on a recorded medium (paragraph [0001], [0007]-[0009]). The recorded medium can store a large number of programs which may take a long time to search. The recorded medium has a program area that stores the programs and a management area which manages the programs as groups. The management area is arranged so that the system can quickly return search results based on a portion of a text string representative of a name.

Kudou describes searching for an album that is added to a playlist (see paragraphs [0472] – [0485]). It does not create the playlist. It adds the album to a playlist (see paragraph [0479]: "With the dubbing apparatus according to the embodiment of the present invention, the user can select play list 510 (album number 510) or play list 502 (album number 502) as a play list to which the search result is registered.") The search process queries a user for a portion of a name and engages the user in a series of queries to determine what the user is searching for (e.g., album, track, etc.). The search results are then produced in an arrangement where the user has to manually press keys to see each result. However, the search results are provided by the system and not by the user. The user browses through the search

results by manually pressing a selection key. When the selection key is pressed, the corresponding track is played. When the user wants to get more text information on the search result, the user presses an information display key. When the user presses the play list registration key, the track or album is added to the playlist.

Novelli allows a user to activate a button on a portable music player so that the music player can mark the currently playing track of music as a reminder that the user wishes to carry out a future action associated with the music track at a later time (see Novelli, col. 6, lines 20 -23). The music player stores the reminder, a marked track, in its memory. The music player is connected to a personal computer. The list of the marked tracks is transferred to the PC and the user interacts with the PC to carry out the future actions.

The user is provided with a menu showing all the marked tracks and the additional actions available to the user. These actions can be to purchase the marked music selection, search for information regarding the marked music selection, and other transactions that require the use of the Internet (see Novelli, col. 7, lines 60 – col. 8, line 9). The user selects from this menu the actions or information that is of interest.

Amended claim 1 recites:

A method of compiling a playlist of digital audio data files using a digital audio data player, the method comprising the steps of:

enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player;

automatically playing sequentially an audio clip from each one of the user-selected set of digital audio data files via an audio output device associated with the digital audio data player;

detecting whether a user input is received via the user input device while each one of the audio clips is being played; and

including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played.

The Examiner contends that the "sequentially playing" step is taught in Kudou (Abstract; section [0015]-[0019]; Claim 6). Applicants respectfully disagree.

Amended claim 1 recites "*automatically playing sequentially an audio clip from each one of the user-selected set of digital audio data files via an audio output device associated with the digital audio data player (emphasis added)."* In Kudou, the system produces the search results and not the user. The user scans through the search results by manually pressing various keys. When a selection key is pressed, the corresponding track is played. By contrast, in amended claim 1, the user selects the files. Then an audio clip of each one of the user-selected files is played back automatically, that is, without requiring a user to press a key to select the track. In addition, each audio clip is automatically played sequentially in turn, that is, one after the other and without relying on the user to press additional selection keys. Clearly, this feature is not recited in Kudou.

In addition, Kudou does not disclose other features recited in the amended claim 1.

Amended claim 1 recites *"detecting whether a user input is received via the user input device while each one of the audio clips is being played."* In Kudou, the keys are pressed in response to text displayed in a display and not while a track is played back (see paragraph [0476]: *"Thereafter, when the controller 101 has judged that the information display key had been pressed while search result "1/2" had been displayed on the display device 102...;* paragraph [0477]: *"Thereafter, when the controller has judged that the information display key had been pressed while "Album 2" had been displayed on the display device 102...").* There is no mention in Kudou of pressing the keys while a track is reproduced. By contrast, amended claim 1 clearly indicates that

the user input in received while the audio clip is being played. Clearly, this feature is not disclosed in Kudou.

Amended claim 1 recites "*including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played*" (emphasis added). As noted above, Kudou does not disclose detecting user input while the currently playing audio clip is being played. As such, this feature is also not disclosed in Kudou.

For these reasons, at least, these features are not disclosed in Kudou.

The following features of amended claim 1 are not disclosed in Novelli.

Amended claim 1 recites "*enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player (emphasis added).*" Novelli discloses a list of marked tracks. The list is used to search for and display transactions that a user can initiate with respect to each marked track. The marked track list differs from a playlist. Clearly, the playlist is not disclosed in Novelli.

Amended claim 1 recites "*automatically playing sequentially an audio clip from each one of the user-selected set of digital audio data files via an audio output device associated with the digital audio data player.*" Novelli does not disclose sequentially playing an audio clip as noted above. This feature, at least, in amended claim 1 is not disclosed in Novelli.

Amended claim 1 recites "*including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played (emphasis added).*" Novelli does not recite a playlist nor recite "*including identifying data*" as noted above. For these reasons, this feature in amended claim 1 is not disclosed in Novelli.

Therefore, even assuming that the references are combined as suggested by the examiner, the combined arrangement still fails to produce the claimed invention.

Furthermore, applicants submit that the Office Action has failed to provide sufficient motivation why one skilled in the art would combine the references in the manner suggested.

The Examiner contends that *"[i]t would have been obvious to one skilled in the art at the time of the invention to modify the Platt taught playlist creation method with a means for searching sequentially through highlights or previews of user selected media as taught or suggested by Kudou. The average skilled artisan would have expected predictable results from such a modification."* Applicants respectfully disagree.

Applicants submit that one of ordinary skill in the art would have absolutely no motivation to modify Platt using the cited teachings of Kudou <u>since the express teachings of Platt teach away from such a modification.</u> In particular, one of Platt's main objectives is to provide a technique which:

"..<u>reduces effort and time required by a user to generate a playlist...[so that] the user is not required to manually search through a collection of media items and select those items that meet the user's current mood or desire in order to generate a playlist.</u>" (emphasis added; see column 2, lines 30 – 36 of Platt).

Kudou requires the user to manually search through search results using various keys – selection keys, information display keys, etc., which is precisely what Platt teaches away from. The use of the teachings of Kudou in Platt would defeat the objective of Platt. Accordingly, there would be no motivation to modify Platt in a manner that would require additional user time and effort.

The Examiner also contends that *"[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to operate the Platt disclosed "ADD" button during playback of a media file as taught by Novelli, thereby indicating preference on the part of the user to include a media item in the Platt playlist and*

causing the sequential reproduction of a next item in the Kudou disclosed sequential stepping method." Applicants respectfully disagree.

One skilled in the art would not modify Platt with Kudou and Novelli in a manner that would require additional user time and effort (see Platt, col. 2, lines 30 – 36). In fact, Kudou and Novelli are targeted for user interactions. In Kudou, the user has to answer a series of queries, input text strings, and press buttons to browse through search results. In Novelli, the user has to mark the tracks of interest, the user downloads the track list to the PC, and the user initiates each subsequent transaction from the menu of options. By contrast, Platt's objective is to minimize the user's manual interactions. One skilled in the art would not combine Platt with Kudou and Novelli in a manner that relies on a significant amount of user interaction.

The lack of motivation to combine Platt, Kudou, and Novelli is further supported by the fact that only one of these references, namely Platt, even addresses the problem of *how to create a playlist using a digital audio data player*, as claimed. Kudou is directed towards searching. Novelli is directed towards creating a reminder of a currently playing music track for future reference. Accordingly, one of ordinary skill in the art, when faced with the problem of *how to create a playlist using a digital audio data player*, would not be motivated to examine art, such as Kudou and Novelli, which are directed towards solving completely different problems.

Conclusion

The remaining independent claims recite the above-referenced features, and are believed to be patentably distinguishable over the cited references for the same reasons as discussed with respect to amended claim 1.

Applicants submit that for at least the reasons discussed above the suggested combination of prior art references fail to disclose or suggest each and every feature recited in the independent claims 1, 8, and 15, and as such, these claims, and the claims that depend there from, are patentably distinguishable over the cited references.

Customer No. 24498
Attorney Docket PU030124
Final Office Action Date: November 10, 2009

Re: Rejection of Claims 2-5, 10-13, 17-20 under 35 U.S.C. §103(a)

Claims 2-5, 10-13, 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Platt in view Kudou in view of Novelli as applied to claims 1, 6, 8, 14, 15, 21 above and further in view of Heo (US Patent 7,046,588). Applicants respectfully traverse this rejection for at least the following reasons.

Applicants respectfully traverse this rejection since Heo is unable to remedy the deficiencies of Platt, Kudou, and Novelli explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

Re: Claims 7, 16 rejected under 35 U.S.C. §103(a)

Claims 7, 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Platt in view of Kudou in view of Novelli as applied to claims 1, 6, 8, 14, 15, 21 above and further in view of Eyal et al. (US PGPub 2002/0116476), (hereinafter, "Eyal").

Applicants respectfully traverse this rejection since Eyal is unable to remedy the deficiencies of Platt, Kudou, and Novelli explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing remarks/arguments and accompanying amendments, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled.

It is believed that there are no additional fees due with regard to the filing of this response. However if an additional fee is due, please charge the fee, or credit any overpayment, to Deposit Account No. 07-0832.

Respectfully submitted,

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